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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,369	12/28/2000	Takehiko Yoshida	38195.33	7895

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/750,369

Applicant(s)

YOSHIDA, TAKEHIKO

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 2-11 and 13-16 were canceled via Paper No. 5. Claims 1 and 12 were amended via Paper No. 5. Claims 1 and 12 are pending in the instant application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

#### **Claims 1 and 12 are rejected under 35 U.S.C. 112, first paragraph.**

Claims 1 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Both claim 1 and claim 12 recite, "An image processing means that is adapted to output via an output means an eyeglass-wearing image with an eyeglass frame image, selected by said frame selection means, being combined with the face image data controlled by the database control means, and the user selects one of the lens according to the doctor's prescription, the presbyopic lens when the user's age is at least about 40 years old, the lens according to the latest vision data the electronic service center or the user has, or the lens based on vision test."

The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention.

**Claims 1 and 12 are rejected under 35 U.S.C. 112, second paragraph.**

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Both claim 1 and claim 12 recite, "When the user's age is at least about 40 years old." The court held that claims reciting "at least about" were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term "about." *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellicano U.S. Patent No. 6,386,707, in view of Izumitani U.S. Patent Application Publication No. 2003/0090625.**

Pellicano discloses a networked-based eyeglass lens and frame ordering and marketing system comprising:

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- A user interface unit (at least Figure 1(a), "10");
- An electronic service center (at least Figure 1(a), "30");
- At least one of a network and a data transmission system connecting the user interface and the electronic service center (at least Figure 1(a), "20");
- An eyeglass frame selection means (at least abstract);
- Means for creating display information relating to eyeglass frames (abstract);
- Vision testing means for testing vision of the user (at least column 1, line 51 to column 2, line 29);
- Means for receiving data, such as a doctor's prescription relating to the user's vision, age and the latest vision data (Pellicano: claim 5);
- An eyeglass lens selection means for selecting eyeglass lenses from among a plurality of eyeglass lenses in response to user input (at least column 1, lines 6-10);
- An eyeglass ordering and marketing means (at least abstract); and
- A display information creating means (at least claim 9).

Pellicano does not expressly disclose the following limitations:

- A user information registration means for registering and controlling a user's information including a face image sent from the user interface unit;
- A frame selection information input means;
- A database control means for storing and controlling a user's face input by the user information registration means;

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- A frame image registration means for inputting frame images provided by the electronic service center;
- A frame selection means that is adapted to select an appropriate one of frame functional structures, frame ornamental structures, and frame images, stored by the frame information registration means, for each frame of the database control means, corresponding to frame selection criteria requested by the user and controlled by the database control means, and is adapted to create or select a frame image for displaying eyeglass frames of different types;
- An image processing means that is adapted to output via an output means an eyeglass-wearing image with an eyeglass frame image, selected by said frame selection means, being combined with the face image data controlled by the database control means, and the user selects one of the lens according to the doctor's prescription, the presbyopic lens when the user's age is at least about 40 years old, the lens according to the latest vision data the electronic service center or the user has, or the lens based on vision test.

Izumitani discloses a system as set forth below, wherein said electronic service center comprises:

- A user information registration means for registering and controlling a user's information including a face image sent from the user interface unit (Figure 1, "Take Frontal Image");

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- A frame selection information input means (at least Figure 1, "Select Basic Design");
- A database control means for storing and controlling a user's face input by the user information registration means (at least Figure 5);
- A frame image registration means for inputting frame images provided by the electronic service center (at least Figure 4);
- A frame selection means that is adapted to select an appropriate one of frame functional structures, frame ornamental structures, and frame images, stored by the frame information registration means, for each frame of the database control means, corresponding to frame selection criteria requested by the user and controlled by the database control means, and is adapted to create or select a frame image for displaying eyeglass frames of different types (at least Figure 4);
- An image processing means that is adapted to output via an output means an eyeglass-wearing image with an eyeglass frame image, selected by said frame selection means, being combined with the face image data controlled by the database control means (at least Figure 4, Figure 5, and Figure 6), and the user selects one of the lens according to the doctor's prescription, the presbyopic lens when the user's age is at least about 40 years old, the lens according to the latest vision data the electronic service center or the user has, or the lens based on vision test (Figure 6).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Pellicano to have included the limitations of Izumitani as discussed above in order to facilitate an interactive system and methodology for conducting vision examinations and prescribing eyeglasses over the Internet (Pellicano: column 1, lines 6-10).

Even though the language of claims 1 and 12 is not considered an invocation of 35 U.S.C. 112, sixth paragraph, it is noted that these functional recitations are not accorded any patentable weight because it merely recites the intended use of a structure. Office personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Please see MPEP section 2106.

### ***Response to Arguments***

Applicant's arguments filed 1/2/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

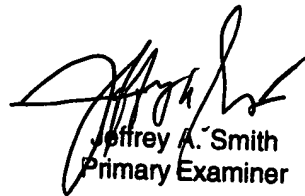
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

January 9, 2004



Jeffrey A. Smith  
Primary Examiner